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| 09/819,712      | 03/29/2001  | Takashi Shinzaki     | 1075.1156           | 4094             |

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EXAMINER

THEIN, MARIA TERESA T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3627

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/819,712

Applicant(s)

SHINZAKI, TAKASHI

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 19-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 29, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/01</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-18 in the reply filed on November 15, 2004 is acknowledged.

Claims 19-64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 15, 2004.

Applicant's is respectfully requested to cancel the non-elected claims in response to the Office action.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on March 29, 2001 is being considered by the examiner. However, JP-T-HEI 11-514763 (related to PCT/US96/17556) is not being considered because there was no English abstract or translation of the Japanese Patent Publication.

***Drawings***

The drawings filed on March 29, 2001 are acceptable.

***Specification***

The disclosure is objected to because of the following informalities: The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-6, 11-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,336,100 to Yamada.**

Regarding claims 1, Yamada disclose an e-commerce method for an e-commerce system, which includes a seller's terminal (virtual stores, Figure 1, col. 2, lines 18-24; retailer, col. 2, lines 35-39), a customer's terminal (customer with a piece of terminal equipment, col. 2, lines 25-27), a payment agent's terminal (account settlement systems, col. 2, lines 59-61); and commodity delivery means (col. 3, lines 6-10), the method comprising: at the customer's terminal sending an order to the seller's terminal for a commodity via the information communication network and designating a non-residential place other than a residential place of the customer as the delivery destination via the communication network (col. 3, lines 1-12); at the seller's terminal notifying the customer's terminal of transaction identification information (col. 3, lines 1-5; col. 3, line 66 – col. 4, line 3), requesting the payment agent's terminal for payment for the commodity for which the customer's terminal made the order (col. 3, lines 1-5; col. 5, line 1-6), making arrangements to deliver the commodity to the non-residential place using the commodity delivery means (col. 3, lines 6-12; col. 3, lines 26-42; col. 4, lines 27-41); and at the commodity delivery means transferring the commodity to a receiver for the commodity at the non-residential place (col. 3, lines 26-42).

Regarding claims 2-6, Yamada discloses certification (col. 3, line 66 – col. 4, line 3); the receiver certifying information which his created at the sellers' terminal and price information of the transaction, together with the transaction ID information are notified to the customer's terminal (col. 2, lines 59-60; col. 3, lines 1-5; col. 3, lines 55-65); the

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customer's terminal notifies the payment's agent terminal of the transaction ID information and the price information, which have been notified by the seller's terminal (col. 2, lines 59-60; col. 3, lines 1-5; Figures 11-12); customer's terminal notifies the seller's terminal of receiver certifying information (col. 3, line 55-col. 4, line 4); a sales slip medium containing said transaction ID information in form of a read-out code (receipt, Figure 12); and the receiver for the commodity is certified as the authorized receiver, by reading out the transaction ID information of the sales slip medium (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6); the transaction ID information is ciphered with the read-out code as a code key (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6, Figure 12); and the ciphered transaction ID information of the sales slip medium is deciphered using the code key (col. 3, line 66- col. 4, line 3; col. 5, lines 4-6, Figure 12).

Regarding claims 11-13 and 15, Yamada discloses upon completion of delivery of the commodity of the non-residential place, the seller's terminal notifies the customer's terminal of the completion of the delivery (col. 3, lines 43-65); certification is made as to whether the receiver for the commodity is an authorized receiver, using receiver certification information (col. 2, lines 57-65; col. 3, line 66- col. 4, line 3); notifying the customer's terminal of a status of delivery of the commodity (col. 3, lines 46-47); and notification to the seller's terminal via communication network that the transferring of the commodity has been carried out in the commodity transferring step (col. 3, lines 43-65).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,100 to Yamada in view of U.S. Patent No. 6,236,972 to Shkedy.** Yamada, substantially discloses the claimed invention, however, it does not disclose digital signature and biometrics. Yamada disclose member discriminating information that discriminates account settlement systems (col. 2, lines 59-65). Yamada further discloses the service provider issues ID cards storing the member discriminating information (col. 2, lines 59-65). Shkedy, on the other hand, teaches digital signatures and biometrics (col. 5, lines 3-7).

Therefor, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Yamada, to include digital signatures and biometrics, s taught by Shkedy, so as to authenticate the customer identification (Shkedy, col. 5, lines 3-4).

**Claim 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,100 to Yamada in view of U.S. Patent No. 6,085,170 to Tsukuda.** Regarding claim 9, Yamada substantially discloses the claimed invention, however, it does not disclose a commodity cabinet. Yamada disclose the delivery of a product to a

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station where the commodity is kept temporarily (col. 3, lines 7-8). Tsukuda, on the other hand, teaches the commodity cabinet (col. 9, lines 38-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Yamada, to include the commodity cabinet, as taught by Tsukuda, in order to store the goods inside the cabinet so that the customer can receive the goods at anytime (col. 11, lines 19-24).

**Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,100 to Yamada in view of U.S. Patent No. 6,085,170 to U.S. Patent No. 6, 609,113 to O'Leary et al.** Yamada substantially disclose the claimed invention, however, it does not disclose the arrangement to pay a predetermined amount of money periodically to a customer's account established for the payment agent to make payment in behalf of the customer and the payment agent makes a direct debit of a price regarding the purchasing of the commodity in the customer's account. Yamada disclose the account settlement system (col. 2, line 60). Furthermore, Yamada disclose a receipt in Figure 12. O'Leary, on the other hand, teaches the arrangement as recited above (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Yamada, to include the payment arrangement, as taught by O'Leary, in order to pay the seller.

**Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,100 to Yamada in view of U.S. Patent No. 6,085,170 to U.S. Patent No. 6,748,365 to Quinlan et al.** Yamada substantially disclose the



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claimed invention, however, it does not disclose the marketing information, discounts and age/sex information. Yamada disclose the member profile information (Figure 3). Quinlan, on the other hand, teaches the marketing information, as recited above (col. 3, lines 26-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Yamada, to include the marketing information, as taught by Quinlan, in order redeem product rebates (Quinlan col. 1, lines 12-13).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
February , 2005

*Michael Cuff 2/7/05*  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**